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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/518,629

03/21/2005

Ryuji Nakagawa

Q85397

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SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, DC 20037

EXAMINER

TOSCANO, ALICIA

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

07/14/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/518,629	<b>Applicant(s)</b> NAKAGAWA ET AL.	
	<b>Examiner</b> Alicia M. Toscano	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-14 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-14 and 17-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-5, 7-14 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakagawa (JP 2000-129037, English translation provided) in view of Nakamura (US 6414073).

This rejection is as set forth in the action dated 1/10/08. It is the Examiner's position that the terpene-phenol resin is a synthetic resin since it would be synthetically produced and not found naturally in nature. Rejection over claims 6, 15 and 16 are removed since said claims are now cancelled. See additional comments below.

2. Claims 1-5, 7-14 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakagawa in view of Sasaka (US 6186204).

This rejection is as set forth in the action dated 1/10/08. It is the Examiner's position that the terpene-phenol resin is a synthetic resin since it would be synthetically produced and not found naturally in nature. Rejection over claims 6, 15 and 16 are removed since said claims are now cancelled. See additional comments below.

### ***Response to Arguments***

Applicant's arguments filed 5/9/08 have been fully considered but they are not persuasive. For the inclusion of Nakamura and Sasaka Applicant argues that the compositions of each are vastly different than that of Nakagawa and the tackifier cannot be easily introduced in the rubber compositions of Nakagawa. Applicant further argues Tables 1 and 2 show unexpectedly superior results.

The Examiner disagrees. Applicant has merely speculated that the tackifiers would not be able to be incorporated into the composition of Nakagawa. Nakagawa discloses styrene-butadiene rubber compositions. Both Sasaka and Nakamura disclose rubber compositions, Sasaka is drawn to styrene-butadiene rubbers (Column 8 line 18), the same as Nakagawa, and Nakamura is drawn to styrene-isoprene rubbers. Isoprene differs to butadiene by only 1 carbon atom and it is the Examiner's position that it would have similar behavior to butadiene. Due to the similarities between the polymers of Sasaka and Nakamura to that of Nakagawa it is unclear why Applicant believes incorporation would be difficult and the Examiner requests evidence to support this position. Without such and for the reasons above, Applicant's arguments are not found persuasive. Regarding Tables 1 and 2, the data is not sufficient to show unexpected results for the inclusion of a tackifier because there is no comparative example of just Resin A and Resin B. Applicant has multiple examples of Resin A, Resin B and various Resin C's, and also examples of just Resin A, however without an example of just Resin A and Resin B the Examiner is unable to ascertain whether the results are unexpected. The Examiner notes that the Example which does contain only Resin A and Resin B

further includes a aromatic oil filler additive which is not standard in the other resin compositions. As such the Tables are not convincing and the rejection stands.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia M. Toscano whose telephone number is (571)272-2451. The examiner can normally be reached on M-F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMT

/Randy Gulakowski/  
Supervisory Patent Examiner, Art Unit 1796